Remarks and Arguments

Reconsideration is respectfully requested.

Claims 1-25 are pending in the present application before this amendment. By the present amendment claims 1, 8-9, 13-14, and 18-19 have been amended. No new matter has been added.

In the office action (page 3), claims 8 and 13-14 stands objected to under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement. More specifically, the examiner objects to the term "evaluation data" that is recited in claims 8, 13, and 14 as being absent from both the original specification and the amended specification submitted August 18, 2008.

The applicant's respectfully disagree. The limitation --evaluation data-- was amended in claims 8 and 13-14 to replace the original limitation of "guiding information." In the previous office action data April 24, 2008, the examiner interpreted the limitation of "guiding information" as a "link" according to the previous office action. Such an interpretation was incorrect and the term "guiding information" was amended to --evaluation data-- to better describe the claimed subject matter.

The word evaluation is derived from the term "evaluate" that means to "ascertain or fix the value or worth of" (see *http://dictionary.reference.com/browse/evaluation*). According to the present invention, data is supplied –to a web browser of the first sponsor-- corresponding to a first advertisement request including –an advertisement keyword--. This is graphically illustrated in FIG. 7b of the present invention depicting an "advertisement subscription screen" (specification page 26, lines 14-21). This information includes such elements as whether a keyword is purchased, contract period, unit price per month, and expected number of possible impressions (specification page 26, lines 14-21). This collected information is provided to the sponsor who makes the --advertisement request-- so the sponsor may "[determine] whether to purchase the relevant keyword with reference to the ... information" (specification page 28, lines 16-19). That is, the sponsor **evaluates** whether it would be prudent to purchase the advertisement keyword **based** on the value or worth of the information provided to the sponsor. Therefore, the term --evaluation data-- more than

adequately describes the information provided to the sponsors based on the disclosure of the specification.

The applicants respectfully submit that the claim limitation --evaluation data-- is fully supported in the specification in at least page 26, lines 14-21, page 28, lines 16-19, and FIG. 7b. Further, the applicants respectfully submit that the term --evaluation data-- is sufficiently clear in light of the specification. Accordingly, the applicants respectfully request withdrawal of the objection to the claim limitation --evaluation data-- as it is descriptive and fully defined within the specification.

In the office action (page 4), claim 19 stands rejected under 35 U.S.C. §102(b) as being anticipated by International Publication No. 02107030 (Nam). The "et al." suffix is omitted in a reference name.

In the Response to Arguments (office action page 18), the examiner appears to erroneously think that –the processing part **for** recording a keyword as history data that corresponds to the received predetermined event from the use– recited in claim 19 should not be given patentable weight for it is directed to "the intended use of structural components." The applicants respectfully disagree and points to MPEP §2173.05(g), which makes it **very clear** that:

> "A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is **nothing inherently wrong** with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart,* 439 F2d 210, 169 USPQ 226 (CCPA 1971)."

In fact, the same section of MPEP **requires** that the functional claims should be treated as and be examined "just like any other limitation of the claim":

> "A functional limitation **must** be evaluated and considered, **just like any other limitation** of the claim, for what it fairly conveys to a person of ordinary skill in the art in the context in which it is used." MPEP §2173.05(g).

The Court in *In re Venezia*, 189 USPQ 149, has held that a limitation performing a function is an acceptable recitation.

> "In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as 'members adapted to be

positioned' and 'portions ... being resiliently dilatable whereby said housing may be slidably positioned' serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)." MPEP §2173.05(g).

Therefore, the functional limitations as recited in claim 19 should be given full patentable weight; however, to avoid the needless controversy on this issue, the applicants have amended claim 19 such that claim 19 recites --a processing part ~~for~~ recording a keyword...-- such that those portions of the limitation after the recitation of the --processing part-- are not merely directed to intended use as alleged.

Again, the examiner's argument that limitations of --recording--, --searching--, and --determining-- of the --processing part-- are merely intended uses is incorrect. The limitations for --recording--, --searching--, and --determining-- define the --processing part-- itself. For example, in the same way the input and output of a circuit block define the structure of the circuit block, likewise does the actions of the --processing part-- define the structure of the --processing part--. That is, the --processing part-- is designed structurally to perform --recording--, --searching--, and --determining--. The limitations that the examiner refuses to given patentable weight to define what the processing part is and to ignore such limitations are to incorrectly interpret the claims as presented. In contradistinction to the examiner's argument, the --processing part-- is defined narrowly according to its function. The limitations recited in claim 19 are not merely a recitation of **intended use**, but rather define how the --processing part-- functions and are therefore valid limitations and should be given patentable weight.

The applicants respectfully re-submit their arguments set forth in the response filed on August 18, 2008 with respect to claim 19. The presently claimed invention is directed to a method and system for evaluating an interested field of a user. More specifically, the present invention does more than merely assume that a keyword of a user is an interested field. Rather, the present invention analyzes information corresponding to the keyword such that the present invention can distinguish between a single instance of a keyword and a legitimate interest of a user. For example, a user may input a keyword "patent" that may be classified according to its type depending on the character of the keyword "patent" (specification page 11, lines 8-11). In the case where a user arbitrarily inputs the keyword "patent" once, it is unreasonable to assume

that the keyword "patent" is an interested field of the user based solely on the single instance of searching the keyword (specification page 11, lines 13-15). Contrasted to where a user inputs a keyword "flower delivery" once, it is reasonable to assume that the user is interested in flower delivery at that instant and is an interested field of the user because of the characteristics associated with keyword "flower delivery" (specification page 11, lines 15-18). That is, a keyword such as "flower delivery" carries with it a sense of immediacy that can be interpreted as the user having a direct interest in the keyword at that moment. By analyzing the user actions (events), the present invention determines whether or not the keywords analyzed are legitimate fields of interest of the user or are merely single instances involving the use of the keyword. As a result, the present invention can provide advertisements that are more specifically tailored to the user.

Now going back to the office action page 4, the examiner asserts that Nam anticipates the presently claimed invention. The applicants respectfully **disagree**.

Nam is directed to an Internet advertising system and method that supplies advertisements based on a user-selected group of interested fields. These advertisements are then provided to the user during a loading time when the user navigates between web pages. Unlike the present, Nam does not attempt to determine whether or not a keyword is an actual interested field of a user. Rather, Nam presents two cases for providing advertisements to users. In the first case where a membership site is used, the user **directly** defines the fields of interest through a questionnaire (Nam page 6, lines 17-19). This is then used to provide advertisements to the user and is independent of a user inputted keyword as in the present invention. In a second case of a non-membership site, characteristics of the web site itself determine the appropriate advertisement to be shown to the user (Nam page 7, lines 13-15). This is more clearly stated in Nam page 8, lines 31-32, which recite:

> "In a secondary step, an applet is activated (S306) to make a request of a search for the database depending on **the subject of the page or on the member information**" (emphasis added).

That is, it is obvious from the disclosure of Nam that Nam does not determine an interested field of a user based on --determining whether the keyword is an interested

field of the user according to the predetermined reference information and type information of the keyword searched in the keyword database-- as in the presently claimed invention. Nam page 15, lines 6-8, discloses clearly the feature of providing an advertisement based on an inputted search key word; however, unlike the present invention, Nam provides an advertisement according to the key word without determining if it is truly an interested field of the user, which is what the presently claimed invention seeks to avoid. As previously stated, the presently claimed invention functions to determine whether the keyword of the user is truly an interested field of the user according to –the predetermined reference information and type information of the keyword searched in the keyword database--. Claim 19 has been amended to further clarify what these information types are so as to give further clarification of the present invention. Claim 19 has been amended as follows, inter alia:

> --a keyword database ~~for~~ recording multiple keywords, type information of the keyword, predetermined reference information that corresponds to the type information, advertisement list information that corresponds to the keyword, in which the advertisement list information includes a number of advertisement files that include the keyword, **wherein the type information defines pattern characteristics of the keyword and the predetermined reference information is comprised of several conditions specific to each type information in the keyword database**;
>
> a communication part ~~for~~ receiving a predetermined event from a user, **wherein the predetermined event is an action taken by the user while utilizing the internet**;
>
> a processing part ~~for~~ recording a keyword as history data that corresponds to the received predetermined event from the user, searching for the type information of the keyword and the predetermined reference information that corresponds to the type information of the keyword by referring to the keyword database, and determining whether the keyword is an interested field of the user according to the predetermined reference information and type information of the keyword searched in the keyword database, **wherein the history data represents use information by the user of the keyword**--.

The support for these amendments can be found in the specification in at least page 10, lines 2-4; page 11, lines 6-19; page 11, lines 20-23; and page 12, lines 13-17.

There is nothing in Nam that teaches –**the type information defines pattern**

characteristics of the keyword-- as claimed. The --type information-- of the present invention describes whether a keyword has a sense of immediacy or whether it is possible to determine whether the entered keyword is a legitimate interested field of the user solely by the word alone, or if additional information regarding the usage of the keyword by the user is needed in to make such a determination (specification page 11, lines 7-19). Nam does not teach --**the predetermined reference information is comprised of several conditions specific to each type information in the keyword database**--. The --predetermined reference information-- is information that has several conditions unique to each type information such as how many times the event is inputted by a user, recentness of the event, and a priority for the event that is set in advance (specification page 12, lines 13-17). Therefore, without teaching --the type information-- and --the predetermined reference information--, Nam can in no way teach --determining whether the keyword is an interested field of the user--. Rather, Nam relies solely on the assumption that an inputted keyword is an interested field of the user. As a result, the present invention is superior to that of Nam since the present invention goes beyond merely an assumption about a keyword, but rather determines whether the keyword is a valid interested field of the user.

Further, the applicants maintain that the examiner's assertion that Item 116 of Nam, i.e., the CGI programming unit, is not analogous to the --advertisement file preparing part-- or the --analyzing part-- as alleged. In Nam, the CGI program unit 116 is described only as being "connected between the WWW server 117 and a database management unit 115" (Nam page 6, lines 6-8). There is nothing in Nam describing what the CGI program unit 116 does. To allege that that the CGI program unit 116 encompasses every type of processing is inaccurate. Further, the examiner asserts that Nam anticipates the present invention under 35 U.S.C. § 102 and therefore Nam must teach each and every aspect of the present invention. The examiner has failed to explicitly show how CGI program unit 116 of Nam is analogous to the --advertisement file preparing part-- or the --analyzing part-- and cannot anticipate the present invention under 35 U.S.C. § 102 as alleged.

Accordingly, since Nam does not teach the claimed --type information--, --predetermined reference information--, --the advertisement file preparing part--, and the

--analyzing part-- for at least the reasons set forth above, the applicants respectfully request withdrawal of the outstanding rejection and earnestly solicit an indication of allowable subject matter with respect to claim 19.

In the office action (page 6), claims 1-7, 18 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nam in view of U.S. Patent No. 6,308,202 (Cohn).

As to claim 1, the applicants respectfully **disagree**.

The applicants respectfully re-assert their arguments with respect to claim 19 that Nam does not teach the claimed --type information-- and --predetermined reference information--. Claim 1 has been amended similarly to claim 19 to more clearly define the --type information-- and the --predetermined reference information--. The support for these amendments are discussed with reference to claim 19 and will not be further described for the sake of simplicity. There is nothing in Nam that teaches the information types in amended claim 1. Rather, Nam at best discloses only recording a keyword and in no way teaches discriminating between keywords to determine if the keyword is an actual interested field of the user. Nam does not disclose anything in the specification to suggest that it is capable of making such a determination and therefore cannot teach the present invention as alleged.

As to the examiner's assertion that Cohn teaches claim 1 of the present invention, the applicants respectfully **disagree**.

The examiner asserts (office action page 7) that Cohn teaches --determining whether the keyword is an interested field of the user in view of the predetermined reference information--; however, there is no such teaching found anywhere in Cohn. Cohn is directed to a system for categorizing "Internet address pointers" according to **their** content and providing advertisements accordingly (Cohn col. 2, lines 55-67). Cohn explicitly acknowledges the problem that the present invention cures. That is, Cohn states that "users will have a wide variety of more transitory interests" that are hard to track (Cohn col. 2, lines 25-27). The "Internet address pointers" of Cohn are URLs that are entered by a user, not keywords as in the present invention (Cohn col. 4, lines 32-44). Additionally, Cohn explicitly teaches away from targeting keyword searches as in

the present invention (Cohn col. 2, lines 41-42). That is, Cohn teaches categorizing URLs using a category database 54 that contains a list of all categorized URLs grouped by category. This is completely different from that of the present invention.

As previously stated, the presently claimed invention determines whether a keyword from a predetermined event of a user is a valid interested field of the user. This is accomplished by analyzing specific characteristics of the keyword. There are cases according to the present invention where a keyword would **not** be deemed an interested field based on the keyword's characteristics. There is nothing in Cohn that remotely suggests such a scenario. Like Nam, Cohn assumes that the entered URL is an interested field without given deference to any other information. The examiner's assertion that Cohn teaches --determining whether the keyword is an interested field of the user in view of the predetermined reference information-- is not supported in light of the amendments to claim 1 defining the information used to determine if the keyword is an interested field of the user.

Item 120 and 160 of Cohn are used to determine categories of URLs **not** keywords as in the present invention. The examiners cites item 180 "Transmit Information to User Terminal" as teaching --generating an advertisement file-- and --generating advertisement information--; however, there is absolutely **no** mention in Cohn referencing item 180 other than in FIG. 4. The applicants are perplexed as to how item 180 of Cohn can be cited by the office action as teaching the above limitations, because the applicants have found nothing in Cohn to support such a conclusion.

Finally, Cohn FIG. 4, items 150 and 170 do not teach any type of --updating--. Item 150 of Cohn teaches instead searching for a URL and if it is not found returning to item 140 to read the next URL (Cohn col. 7, lines 15-25). Item 150 of Cohn does not "update." Likewise, item 170 transmits information **to the user** based on a category of a URL (Cohn col. 7, lines 26-37). Again, there is absolutely no mention of updating anything in Cohn, and therefore Cohn **cannot** teach --updating a number of advertisement files in the advertisement list information stored in the keyword database-- as in the presently claimed invention.

Accordingly, neither Nam nor Cohn whether considered individually or in combination, teaches or suggests the limitations of amended claim 1 at least for the

reasons set forth above. Therefore, the applicants respectfully request withdrawal of the outstanding rejection and an indication of allowable subject matter with respect to amended claim 1.

As to claim 18, the applicants respectfully reassert the arguments with respect to claim 1. Claim 18 is a Beauregard claim and claims the method of claim 1 embodied on a computer-readable medium. Data structures and computer programs are considered to impart functionality when encoded on a computer-readable medium. When such data structures or computer programs are recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be considered statutory. In this manner, the applicants submit that claim 18 is considered to be in condition for allowance as the data structure or the computer programs performing the acts recited in claim 18 are enclosed on a computer-readable medium.

Further, the acts recited in claim 18 have also been amended in the same manner as claim 1. Therefore, regardless of the patentability analysis of claim 18 with respect to the subject matter of the computer readable medium, the applicants respectfully submit that neither Nam nor Cohn whether considered individually or in combination, teaches or suggests every act in the amended claim 18, for at least the same reasons set forth above with respect to claim 1. Accordingly, the applicants respectfully request withdrawal of the outstanding rejection and an allowability indication of the amended claim 18.

In the office action (page 9), claims 8, 10-17, 21 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nam in view of Cheung.

The presently claim invention is directed to a method for attracting advertisements for keywords generated according to the method of claim 1. More specifically, specification page 27, lines 13-16 discloses a sponsor making an advertisement request including an advertisement keyword. The advertisement request includes a keyword that the sponsor is interested in purchasing to associate advertisements with the keyword. The presently claimed invention then searches for the provided advertisement keyword in the keyword database and provides evaluation

data to the sponsor if the advertisement keyword is found in the keyword database (specification page 28, lines 16-19). If the advertisement keyword is **not** found in the keyword database, a request counter is incremented (specification page 27, line 23 - page 28 line 2; FIG. 8). That is, the request counter acts as a measure of interest in the advertisement keyword such that if the request counter reaches a certain threshold value, the present invention will be begin maintaining information about the keyword such that a subsequent advertisement request can be processed (specification page 28, lines 2-16).

To more clearly recite these limitations, claim 8 has been amended to include the –input counter-- recited in claim 9 and also to clarify the –advertisement request–. Claim 8 has been amended as follows, inter alia:

> --receiving a first advertisement request that includes an advertisement keyword from a first sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database **and the advertisement request is a request for purchasing the advertisement keyword by the first sponsor**;
>
> searching for the advertisement information that corresponds to the advertisement keyword by referring to the keyword database **and if there is no advertisement information corresponding to the advertisement keyword in the keyword database, recording the received advertisement keyword and an input counter value for the advertisement keyword in a predetermined storing means**–.

The support for these amendments can be found at least in the specification page 27, line 13 - page 28, line 23; FIG. 8.

Unlike the presently claimed invention, Nam does not teach the --first advertisement request– and does not teach the --input counter– in the amended claim 8.

The examiner asserts that the "request of an advertiser" of Nam on page 13 teaches the --first advertisement request-- of claim 18. However, the "request of an advertiser" of Nam is **not** the same as the claimed --first advertisement request–. Whereas the claimed --first advertisement request-- is --a request for purchasing the advertisement keyword by the first sponsor–, Nam only teaches a request by an advertiser for "classif[ying] [advertisements] according to their directories" (Nam page

13, lines 20-23). This teaching of Nam is completely different from the --first advertisement request-- of the presently claimed invention that represents a --request for purchasing--. Nowhere in Nam mentions the notion of a purchase request by a sponsor as in the presently claimed invention, and therefore Nam cannot teach the --first advertisement request-- as in the amended claim 8.

Nam also does **not** disclose the --input counter-- or the --input counter value-- of the presently claimed invention. To show that --input counter value-- is taught by Nam, the office action page 17 points to Nam page 3, line 20 as teaching the claimed --input counter--. The applicants, however, are rather confused by this conclusion over Nam for the following reasons.

Nam teaches that when a user accesses a non-membership site, the characteristics of the visited website are stored in a cookie (Nam page 3, lines 19-20). Then, based on the information stored in the cookie, an advertisement is searched for according to the information in the cookie and transmitted to the user (Nam page 3, lines 20-22). Absent from Nam is anything relating to an --input counter-- and further, whether the --input counter-- is formed based on a condition where an advertisement keyword supplied by an advertisement request from a sponsor is not found in a keyword database. The applicants found nothing in Nam to even remotely suggest such a scenario. The examiner is construing the storing of data in a cookie in Nam as teaching a --counter-- and conditions, but this not supported anywhere within Nam. For the same reasons, Nam does not teach the --recording [of]....first advertisement data **from the first sponsor**--. The data stored in the cookie of Nam is information concerning characteristics of a visited website and has nothing to do with information --from [a] first sponsor--.

Accordingly, neither Nam nor Cheung whether considered individually or in combination, teaches or suggests all the limitations of amended claim 8. Specifically, neither Nam nor Cheung teaches or suggests the --advertisement request-- representing a purchase request of --a first sponsor--, --an input counter-- that is stored when no advertisement information corresponding to an advertisement keyword from a sponsor is found in a keyword database, and --recording ...first advertisement data from the first sponsor-- in --a first advertisement database--. Therefore, the applicants

respectfully request withdrawal of the outstanding rejection and an indication of the allowable claim 8.

As to claim 13, the applicants respectfully **disagree** with the examiner that Nam and Cheung teach all the limitations of claim 13. Claim 13 has been amended like claim 8 to more clearly define the --advertisement request ... from a sponsor--. That is, claim 8 has been amended to include –**and the advertisement request is a request for purchasing the advertisement keyword by the first sponsor**--. Therefore, the applicants respectfully resubmit their arguments with respect to claim 8. Specifically, nowhere in Nam nor Cheung is it taught an --advertisement request...from a sponsor for --purchasing the advertisement keyword by the first sponsor--.

Accordingly, neither Nam nor Cheung whether considered individually or in combination, teaches or suggests all the limitations of amended claim 13 for at least the reasons set forth above. Withdrawal of the outstanding rejection and an indication of allowable claim 13 are respectfully requested.

As to claim 14, the applicants respectfully **disagree** with the examiner that Nam and Cheung teach all the limitations of claim 14. Claim 14 has been amended like claim 8 to more clearly define the --advertisement request ... from a sponsor--. That is, the claim 8 has been amended to include –**and the advertisement request is a request for purchasing the advertisement keyword by the first sponsor**–. Therefore, the applicants respectfully resubmit their arguments with respect to claim 8. Specifically, nowhere in Nam nor Cheung is it taught an --advertisement request....from a sponsor for --purchasing the advertisement keyword by the first sponsor–.

In the office action page 15, the examiner further states that Nam teaches -- constructing a user interface-- as in the present invention. However, as amended, claim 14 provides a --user interface-- --**such that both the first advertisement data and the second advertisement data are provided to the user simultaneously**--. The support for this amendment can be found in the specification in at least page 31, lines 20-25. The present invention provides a user interface screen such that first advertisement data **and** the second advertisement data can be provided **together** to the user's terminal. There is no such teaching found anywhere in Nam or Cheung. Nam explicitly

states providing an advertisement to a user one at a time. That is, Nam teaches that after an advertisement has been displayed for a predetermined period of time, another advertisement is then searched and placed (Nam page 16, lines 27-29). This is entirely different that of the present invention where two advertisements can be searched, arranged, and provided to the user via a user interface screen.

Accordingly, neither Nam nor Cheung whether considered individually or in combination, teach or suggest all the limitations of amended claim 14 for at least the reasons set forth above. Accordingly, the applicants respectfully request withdrawal of the outstanding rejection and earnestly solicit an indication of allowable subject matter with respect to amended claim 14.

As to claims 2-7, 10-12, 15-17, and 20-25, the applicants respectfully submit that these claims are allowable at least since they depend from independent claims 1, 8, 12, 14, and 19 that are now considered to be in condition for allowance for the reasons set forth above.

For the reasons set forth above, the applicants respectfully submit that claims 1-25 pending in this application are in condition for allowance over the cited references. Accordingly, the applicants respectfully request reconsideration and withdrawal of the outstanding rejections and earnestly solicit an indication of allowable subject matter. This amendment is considered to be responsive to all points raised in the office action. Should the examiner have any remaining questions or concerns, the examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

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